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In re Application of : DECISION ON
EULER et al. :
Application No.: 09/762,863 :
PCT No.: PCT/US99/19601 : PETITION UNDER
Int. Filing Date: 25 August 1999 :
Priority Date: 26 August 1998 : 37 CFR 1.47(a)
Attorney's Docket No.: 4463 :
For: THIN FILM STRAIN SENSORS BASED ON :
INTERFEROMETRIC OPTICAL MEASUREMENTS :
:

This is a decision on applicants' "Completion of Filing Requirements" under 35 U.S.C. §371 including a Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor, treated as a petition under 37 CFR 1.47(a), filed 02 May 2001. The communication, in effect, requests the acceptance of the application without the signature of named inventor, Gregg C. Huston. Applicants also request a one month extension of time, which is granted.

BACKGROUND

On 14 February 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national fee.

On 08 March 2000, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and requisite surcharge for filing the oath or declaration after the 30-month period was required. The Notification set a time period within which to respond and allowed for extensions of time under 37 CFR 1.136(a).

On 02 May 2001, applicants filed the instant petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition, in effect, requests status under 37 CFR

1.47(a) on the grounds that third-named inventor, Gregg C. Huston, is unavailable.

Submitted with the petition, *inter alia*, is the declaration of William B. Euler. Mr. Euler is the first named inventor in the above referenced application.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicants satisfied Item (1) with the payment of the petition fee. As for Item (3), Mr. Euler's declaration gives last known address of Gregg S. Huston, not for Gregg C. Huston, the listed inventor identified on the publication of the international application. Thus, applicants have not satisfied Item (3) above since the international application identifies Gregg C. Huston as the third named inventor, not Gregg S. Huston.

Regarding item (4) above, applicants have provided a declaration executed by co-inventors William B. Euler and Gregory J. Otto on behalf of nonsigning inventor, Gregg S. Huston. However, as noted above, the international application identifies Gregg C. Huston, as the third named inventor, not Gregg S. Huston. Item (4) has not been satisfied. See 37 CFR 1.47 and MPEP 409.03 (a) and (b).

However, with regard to Item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), **Proof of Unavailability or Refusal**, states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

(Emphasis added.)

The declaration of William Euler attempts to provide details of the *bona fide* attempts that were made to contact the non-signing inventor. Mr. Euler's declaration states on or about October 1999 that he 'attempted to contact Mr. Huston by phone and e-mail regarding the above-referenced application at his last known residence and was unsuccessful.' (Decl., ¶4) Mr Euler also states that about October 1999, he "inquired of Mr. Huston's former home custodian to determine the new residence of Mr. Huston and was not successful."(Decl., ¶5)

Mr. Euler's declaration is lacking in significant details. Specifically, he gives no information as to the time of day when he went to the home, whether Mr. Huston could reasonably have been expected to be there, whether he left any written communication indicating that he would return the next day, etc. Nor does he give specific details regarding his attempts to reach Mr. Huston by telephone or e-mail. Without specific detail as to Mr. Euler's attempts, his declaration is insufficient to support Mr. Huston's unavailability or refusal to sign the declaration.

Furthermore, it is noted that the petition cannot be accepted on the grounds that Mr. Huston refuses to sign, in that before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the national stage application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. The declarations provided do not indicate that Mr. Huston was presented with or was attempted to be presented with a copy of all of the national stage application papers for this application as identified above. Evidence of a refusal to sign a declaration for this application without a copy of the specification, including claims, and any drawings being presented to the non-signing inventor is not convincing that Mr. Huston would have refused to execute the application.

Applicants have not fulfilled the requirements of items (2), (3) and (4) above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

Should status under 37 CFR 1.47(a) not be successfully completed, the international application will be viewed as having become abandoned with respect to the United States.

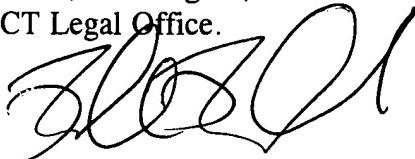
Any reconsideration on the merits of this petition must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the

Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



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